

REMARKS

The election of species requirement is based on lack of unity of invention. However, this election requirement is traversed because it is incongruous with the holding in PCT/EP2004/008346 which is the PCT application upon which this National Phase application is based. During the International Search conducted for the PCT application, no lack of unity of invention was made during the search and all 22 claims were considered (databases searched were EPO-Internal, WPI data, PAJ, Chemical Abstracts, MEDLINE, BIOSIS and EMBASE).

Unlike a U.S. application based on a foreign priority document, the decisions of the Examiner in the PCT application is relevant when considering whether a lack of unity of invention is made in the National Phase U.S. application.¹ No evidence or explanation has been provided as to why the present invention lacks unity of invention as each of the claims are ultimately linked to same inventive concept described in claim 1 of the present invention and no previously holding of lack of unity had been made.

Even if an explanation had been given for lack of unity of invention², a reason for contradicting the position of an Examiner's previous holding has not been established.

Therefore, the lack of unity of invention should be withdrawn.

¹ In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2. (see MPEP 1850, section I)

² There are three particular situations for which the method for determining unity of invention contained in PCT Rule 13.2 is explained in greater detail:

- (A) Combinations of different categories of claims;
- (B) So-called "Markush practice"; and
- (C) Intermediate and final products.

Principles for the interpretation of the method contained in PCT Rule 13.2, in the context of each of those situations are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of PCT Rule 13.2.

Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO's web site (www.wipo.int/pct/en/texts/gdlines.htm). - (see MPEP 1850, section III).

CONCLUSION

In view of the above, reconsideration and withdrawal of the restriction/election of species requirement is respectfully requested.

It is also believed that the application is in condition for allowance, and favorable consideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Favorable action is earnestly solicited.

Respectfully submitted,

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